

REMARKS

Amendments

Claims 12 and 13 of the original application inadvertently were merged together into a single claim 12. Claim 12 of the preliminary amendment contained two sentences, the first with the material of claim 12 of the original application, and the second with the material of claim 13 of the original application, with claim 13 missing altogether. For example, nothing therein indicated cancellation of claim 13. These claims are now separated back into two claims. No markup for this separation of inadvertently merged claims is provided as it is clear that merely a clerical error occurred in the preliminary amendment.

In claim 4, in the definitions of W, X, Y and Z, the group H is added, which group was inadvertently not in these groups' definitions in the claims. Support for this amendment can be found, for example, in the numerous examples in the specification, where it is apparent that any of these groups may also be hydrogen. Moreover, claim 7 recited that W and Z preferably denote H.

In claim 3, the definition of n^1 no longer includes 0.

In the definitions of L, M and N, the term "remainder of the molecule" was clarified by inserting the structure of what is in context clearly the remainder of the molecule.

Also in the definition of L, M and N, the term "all six types of group[s]" were changed to explicitly recite what in context of the application clearly are the six groups. This term should have read as follows: "the latter six types of groups."

Also in the specification in the definition of L, M and N, the term "K preferably denotes" was fixed to "L, M and N." This correction is the correction of an obvious error, whose correction is also obvious. Additionally, to the recitation of preferred groups of K, in the definitions of L, M and N, it is clear that the preferences cannot refer to K, because K cannot be phenyl, for example.

The definition of R^{*1} in claim 5, did not include all the narrower groups of R^{*1} in claim 6. The broader definition of R^{*1} in claim 5 is merely modification in view of this.

Objections

The specification is objected because of a lack of cross-reference to related applications. The Office Action points to 37 CFR 1.78. This section of the rules provides that "cross references to other related applications may be made when appropriate." There is no requirement that cross references be made. It is merely a choice as apparent from the term

“may be made.” Applicants respectfully decline to make cross references to other applications in the specification, especially in view of applicants not being clear on what applications the Examiner is referencing.

The Rejections Under 35 USC § 112, first paragraph

The first rejection of claims 1, 2, and 9 are overcome by the amendments. This does not mean that applicants acquiesce with the rejection, but merely that applicants wish to expeditiously advance the prosecution of this application.

Claims 3, 4, 5 and 7 are rejected as allegedly not enabled for reciting R^{*1} being a “chiral radical.” The rejection states that this term is “too broad,” and points to a prior art compound which allegedly is not enabled by the specification.

The burden is upon the PTO to provide evidence shedding doubt on the disclosure that the invention can be made and used as stated; see, e.g., *In re Marzocchi*, 439 F.2d 220, 169 USPQ 367 (CCPA 1971) (holding that how an enabling teaching is set forth, either by use of illustrative examples or by broad terminology, is of no importance. The disclosure must be taken as in compliance with the enabling requirement of the first paragraph of § 112 unless there is reason to doubt the objective truth of the statement contained therein.) No such evidence or reason for doubting Applicants’ disclosure is provided. Thus, the rejection is not supported.

The Office Action merely alleges that the R^{*1} group is too broad and points to a prior art compound. However, as can be seen from *Marzocchi*, merely having a broad term is not an enablement issue. No evidence or objective reasoning is provided as to why one skilled in the art would not be able to make compounds within the scope of the current definition of R^{*1}, including the prior art compound pointed to by the Office Action.

Moreover, applicants need not teach what is already in the prior art. Enablement is viewed in the context of what one of ordinary skill in the art knows, and such persons of ordinary skill in the art, for example, can make the compounds of the prior art based on, for example, the cited reference’s disclosure. See, for example, *Spectra-Physics v Coherent*, 827 F.2d 1524, 3 USPQ2d 1737 (Fed. Cir. 1987) stating that “a patent need not teach, and preferably omits, what is well known in the art.”

See also *Amgen v Hoechst Marion Roussel*, 65 USPQ2d 1385 (CA FC 2003) holding that the “specification need not explicitly teach those in the art to make and use the invention; the requirement is satisfied if, given what they already know, the specification teaches those

in the art enough that they can make and use the invention without 'undue experimentation.'" Making the compounds of the claimed invention having the claimed R*¹ groups is routine for those of ordinary skill in the art. Thus, explicitly providing examples of all possible embodiments is not necessary to enable the same. See, for example, *In re Howarth*, 654 F.2d at 105, 210 USPQ 689 (CCPA 1981) ("An inventor need not ... explain every detail since he is speaking to those skilled in the art."); *In re Gay*, 309 F.2d 769, 774, 135 USPQ 311 (CCPA 1962) ("Not every last detail is to be described, else patent specifications would turn into production specifications, which they were never intended to be.").

The specification, even though not necessary for an enabling disclosure, provides numerous, i.e., 180, synthesis examples for preparing various species of the claimed compounds. This is more than adequate to enable the claimed invention as there is no requirement that an applicant provide examples directed to the preparation of each and every species of a claimed invention. See, for example, *In re Angstadt*, 537 F.2d at 502-03, 190 USPQ 214 (CCPA 1976) (deciding that applicants "are *not* required to disclose *every* species encompassed by their claims even in an unpredictable art"); *Utter v Higara*, 845 F.2d at 998-99, 6 USPQ2d 1714 (CAFC 1988) (holding that a specification may, within the meaning of Section 112 Para. 1, enable a broadly claimed invention without describing all species that claim encompasses).

Applicants submit that the claims are enabled and that the USPTO has failed to meet its burden of establishing lack of enablement.

The Rejections Under 35 USC § 112, second paragraph

These rejections to the form of the claims are overcome by amendments.

The Rejections Under 35 USC § 102

The rejections over Schoenfelt and Lind are moot.

Claims 1, 2 and 9 now depend on claim 3.

In Claim 4, please note the definitions of W, X, Y and Z.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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